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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,153	03/17/2004	Michael V. Chobotov	760-243 CON II	5039
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HOFFMANN & BARON, LLP			MILLER, CHERYL L	
6900 JERICHO TURNPIKE			ART UNIT	PAPER NUMBER
SYOSSET, NY 11791			3738	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/803,153	CHOBOTOV, MICHAEL V.
	<b>Examiner</b>	<b>Art Unit</b>
	Cheryl Miller	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 March 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 and 3-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

The applicant has argued that Fogarty does not disclose a single graft that has doesn't have sufficient mechanical strength in a deployed state to provide a desired amount of support to a body lumen. The examiner disagrees. First, the applicant has claimed a "desired amount of support". Applicant has not claimed or have support for any specific numerical value of support or thickness. A "desired amount" could be a variety of values depending upon the choice of the surgeon. For example, Fogarty's "desired amount" of support in the overlapping graft areas is the amount of support provided by two graft members, and inherently the one graft would not provide the "desired amount", since in that area, there are 2 overlapping grafts and the "desired amount" of Fogarty in the overlapping area is the amount of support provided by two grafts, not one. Secondly, each member is a stent-graft, and the graft members alone do not provide any support to the vessel, it is the stent that provides the support, and therefore, all grafts used alone would not provide sufficient strength to hold open the vessel.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9 and 11 recite, “graft member does not have sufficient mechanical strength in the deployed state to support the passageway”. Claims 10 and 12-13 depend upon claims 9 and 11 and inherit problems associated with the claims. Applicant *only* has support for a mechanical strength for providing a *desired amount of support* (which a desired amount of support could be no support, minimal support, intermediate support, full support, etc, not necessarily full support, could be any amount of support, it is unclear what the desired amount is). Applicant does not have support for a mechanical strength to support the passageway (which claims full support). Providing strength to support is not the same as providing strength to provide a desired amount of support.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-22 of U.S. Patent No. 6,331,191 B1 to Chobotov (cited in IDS). Although the conflicting claims are not identical, they are not patentably distinct from each other because once an applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent for the generic or broader invention. The application claims are merely broader than the patented claims. The patented claims “anticipate” the application claims. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). The amendment to claim 1 incorporating claim 2 is present in Patent 6,331,191, claim 2.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, 7-15, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Fogarty et al. (US 6,123,722, cited previously). Referring to the product claims 1-5, 7, 8, 14-18, Fogarty discloses an endovascular graft or kit (60, 90) comprising a plurality of separate thin walled graft members (62, 64, 66; 92, 94) configured to be layered (Fogarty’s graft are *capable of* being layered; see figs.3-5). Fogarty discloses two or three graft members, together being able to support a body lumen (col.3, lines 56-65). Fogarty discloses one of the graft members (64 for example in fig.3 or 94 in fig.4, *configured to be placed* on the inner most location) having the

greatest length. Fogarty discloses the graft members to be capable of being delivered individually (fig.5; col.6, lines 55-68). Fogarty discloses anchoring mechanisms (barbs 83 or flare seen in fig.6c) on the ends of the graft members. Fogarty's "desired amount" of support in the overlapping graft areas is the amount of support provided by two graft members, and inherently the one graft would not provide the "desired amount", since in the area of overlap, there are 2 grafts and thus the "desired amount" of Fogarty in the overlapping area is the amount of support provided by two grafts, not one. Also, each member is a stent-graft, and the graft members alone do not provide the support to the vessel, it is the stent that provides the support to the graft and to the vessel (col.6, lines 2-6; col.9, lines 7-8), and therefore, all grafts used alone would not provide sufficient strength to hold open the vessel.

Referring to claims 9-13, Fogarty discloses a method of deploying a graft comprising providing at least two thin graft members, delivering one through a catheter (30) and deploying the one, then delivering a second thin graft through a catheter (30) and deploying the second within a lumen of the first (fig.5a-5c; col.6 line 55-col.7 line 5). Fogarty has shown the inner graft (66 in fig.3) to extend longitudinally from an end of the outer graft (62; see fig.3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fogarty et al. (US 6,123,722, cited previously). Fogarty discloses a layered endovascular graft (60, 90;

fig.3-5; see above) having expansion capabilities on a catheter substantially as claimed. Fogarty does not disclose however, the exact dimensions of the catheter diameter nor the compressed graft diameters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the dimension claimed since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheryl Miller



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